

REMARKS/ARGUMENTS

Claims 8, 16, 18, 24 and 31 have been amended; claims 34-43 have been added and claims 1-7, 9-15, 17, 19-23, 25-30 and 32-33 remain unchanged. Thus, claims 1-43 are pending.

Claims 1-33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. (USP 6,549,894) in view of Cronin (US Pub. No. 2001/0039505) and MacPhail (USP 5,107,419).

As amended, all the pending claims of the subject application comply with all requirements of 35 U.S.C. Accordingly, Applicant requests examination and allowance of all pending claims.

Previously Filed Information Disclosure Statement

Applicants filed an IDS on March 6, 2003 for the present application and have received a stamped postcard from the USPTO indicating that this IDS was properly received. Accordingly, Applicants respectfully request that the Examiner consider each of the references cited in the IDS during the prosecution of this application and that an appropriate copy of the PTO 1449 form accompanying the IDS be returned to Applicants with the Examiner's initials next to each reference so considered. Applicants brought this to the Examiner's attention in their Response filed November 4, 2003, but still have not received an initialed PTO-1449 form.

The Rejection Under 35 U.S.C. 103(a)

Claims 1-33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. (USP 6,549,894) in view of Cronin (US Pub. No. 2001/0039505) and MacPhail (USP 5,107,419). Applicants respectfully assert that a *prima facie* case of obviousness has not been established for any of the claims and that this rejection is respectfully traversed.

A. Claims 1-10:

With respect to the rejection of claim 1, Simpson et al. (the primary reference) teaches an IP docketing system that can track a list of actions and due dates associated therewith and calculate due dates for future actions. Col. 3, lines 4-8. The Examiner acknowledges that Simpson et al. does not teach (1) storing a plurality of electronic documents associated with patent applications or (2) storing a rule that indicates specific document types to be deleted in response to the occurrence of a predetermined event as recited in claim 1. The Rejection argues, however, that deficiency (1) is either obvious to a person of ordinary skill in the art or taught by secondary reference Cronin and that MacPhail makes up for deficiency (2). Applicants respectfully disagree as set forth in detail below.

Claim 1 recites "storing a plurality electronic documents related to a patent application in a database accessible to a server system, wherein each of said plurality of electronic documents has a document type and wherein said plurality of stored documents includes at least one document having a first document type and at least one document having a second document type".

With respect to deficiency (1) being taught by Cronin, the Rejection states:

"Cronin teaches this it is well known to store a plurality of electronic documents related to a patent application in a database accessible to a server system. It would have been obvious to one having ordinary skill in the art at the time the invention was made to store a plurality of documents related to a patent application in a database accessible to a server system as taught by Cronin since Cronin states at paragraph [0042] that such a modification would allow the tracking of intellectual property (IP) documentation and provide a formal review of IP documentation." Office Action, page 4, first full paragraph.

Applicants have carefully reviewed Cronin and respectfully assert that Cronin does not teach storing a plurality of electronic documents related to a patent application in a database. Cronin teaches storing over 40 different types of data associated with inventions tracked by the system (see for example, paragraphs [0049] to [[0155] listing information such as Invention ID number, area, company name, company site, etc.). A person of ordinary skill in the art will appreciate that electronic documents are documents in electronic form that are stored as one or more files. None of the various data types stored in the system taught by Cronin are

electronic documents. Instead, the data stored in the Cronin system includes various database fields such as alphanumeric fields, date fields, numeric fields, etc.

Applicants further note that paragraph [0042] specifically referred to in the Rejection states that the IP review board tracking component of Cronin tracks the schedule and results of the invention review board process. It does not state that electronic documents are stored in Cronin system. Moreover, even assuming *arguendo* that Cronin teaches storing electronic documents, there is no disclosure or suggestion in Cronin that some documents have a first document type while other documents have a second document type as recited in claim 1.

Thus, for at least all of the above reasons, Applicants respectfully assert that Cronin does not make up for deficiency (1) of the primary reference.

Applicants also respectfully assert that deficiency (1) is not obvious to a person of ordinary skill in the art based upon the Simpson reference alone. The Examiner states that "storing patent application data in a database was well known at the time of the invention and that storing such information is deemed helpful to a user writing or tracking the status of a patent application so that the data can be retrieved when needed since deadlines and filings are dictated by statutes." Office Action, paragraph spanning pages 3 and 4. Applicants remind the Examiner that claim 1 recites storing a plurality of electronic documents, not just "storing patent application data" as this paragraph of the Rejection suggests, and that such stored electronic documents include at least some documents having a first document type and other documents having a second document type. If this aspect of the invention is as well known as the Examiner believes it to be, Applicants respectfully request that the Examiner provide a reference to that affect. Absent such a reference, Applicants respectfully assert that a prima facie case of obviousness cannot be established.

With respect to deficiency (2), the Examiner states "MacPhail teaches that it is known to store a rule in said database that indicates specific document types to be deleted from said database in response to a predetermined event occurring related to a document, wherein said rule indicates that documents of said second type should be deleted but not documents of said first type." Office Action, page 4. No specific reference is made to any part of the MacPhail patent, however, for this teaching.

As stated in the last Response, Applicants have reviewed the MacPhail reference in detail and respectfully assert that MacPhail does not teach "storing a rule that indicates specific document types to be deleted" as recited in claim 1. Instead, MacPhail teaches that documents can be retained or deleted by setting document expiration dates for different labels associated with the documents. The system in MacPhail then compares a document's expiration dates with the current system date in order to determine if a specific documents should be deleted or retained. See e.g., col. 4, lines 1-4. The only rules disclosed by MacPhail are rules that calculate the expiration date as discussed with respect to Figs. 12a, 12b and 13a-13d. See col. 10, lines 1-41. Such rules do not delete documents based on a document type associated with the document as required by claim 1. If the Examiner disagrees, it is respectfully requested that the Examiner explicitly point out what in the MacPhail reference corresponds to the rules recited in claim 1.

Thus, for the reasons set forth above, Applicants respectfully assert that MacPhail does not make up for deficiency (2) of the primary reference.

Accordingly, Applicants assert that the Simpson, Cronin and MacPhail references cannot combine to make the invention of claim 1 obvious to a person of skill in the art. Accordingly, Applicants respectfully request withdrawal of the Section 103 rejection of claim 1 and its dependent claims, claims 2-10.

Applicants further assert that the rejection of each of the dependent claims is deficient. 37 CFR §1.104(c)(2) states that the pertinence of each reference must be clearly explained when rejecting a claim. See also MPEP §707 and §707.05 (when prior art is cited its pertinence should be explained). The present Rejection of claims 2-10 does not meet this requirement of the CFR. Instead, in rejecting each of these claims the Examiner references a section of the Simpson reference as teaching one or more of the elements recited in each dependent claim but makes no explanation at all as to the relevance of the referenced section. Applicants have reviewed the rejection of each dependent claim and cannot determine how the Examiner is applying the reference against the claim. For example, with respect to claim 3, what in the Simpson references corresponds to the "client system" recited in the claim and what corresponds to the "signal" recited in the claim; with respect to claim 4, how does a system that

does not even store documents keep track of the type of such nonexistent documents; what corresponds to the "signal" recited in claim 7; what corresponds to the "third document type" recited in claim 8 and the "fourth document type" recited in claim 9. Without any explanation whatsoever of the relevance of the Simpson reference to each of these dependent claims, Applicants assert that a *prima facie* case of obviousness has not been established for any of the claims.

B. Claims 11-15:

Similar to claim 1, claim 11 also requires storing a plurality of electronic documents related to a patent application. Simpson does not teach or suggest this element of the claims as discussed above. Accordingly, Applicants respectfully assert that rejection of claim 11 is improper.

Claim 11 also recites a number of other elements not recited in claim 1 including, for example, that each of the stored electronic documents has an attribute associated with it and that a rule is stored that deletes documents based on the value of this attribute. The Rejection states that these elements of claim 11 are taught by Simpson and Cronin as discussed with respect to claim 1. See Office Action, pages 6-7. Claim 1 does not recite that the electronic documents have an attribute associated with them, however, and the Rejection does not explain the pertinence of Simpson (or Cronin or any other reference) towards this claimed features. Accordingly, Applicants assert that, for this additional reason, a *prima facie* case of obviousness has not been established with respect to claim 11.

Applicants further assert that the rejection of each of the claims that depend from claim 11 is deficient because the pertinence of the Simpson and other references to each claim is not explained in the Rejection. Applicants assert that a *prima facie* case of obviousness has not been established for any of the claims for this additional reason.

C. Claims 16-18:

Claim 16 is an apparatus claim that requires a processor, a database and a program stored in a memory that operates to store an invention disclosure, a patent application and unofficial documents related to the patent application in the database. As discussed above,

Simpson does not disclose such an apparatus. To the extent that Simpson discloses a docketing system that includes a database that stores docketing information there is no disclosure in Simpson that the database also stores an invention disclosure, a patent application and unofficial documents related to the patent application as required by claim 16. Furthermore, Cronin does not make up for this deficiency in Simpson. Also, neither Simpson, Cronin or MacPhail disclose a program that operates to "receive an instruction to categorize said patent application as allowed and automatically delete said unofficial documents related to the patent application" as recited in claim 16. If the Examiner disagrees, it is respectfully requested that the Examiner explicitly point out what in either the Simpson, Cronin or MacPhail reference corresponds to the recited instruction.

In view of the above it is evident that the Simpson, Cronin and MacPhail references cannot combine to make the invention of claim 16 obvious to a person of skill in the art. Accordingly, Applicants respectfully request withdrawal of the Section 103 rejection.

Applicants further assert that the rejection of each of the claims that depend from claim 16 is deficient because the pertinence of the Simpson, Cronin and/or MacPhail references to each claim is not explained in the Rejection. For example, claim 17 recites that the claimed processor is operative with the claimed program to allow a client system to set-up "workflow rules related to defining specific types of documents to be deleted and/or specific types of documents to be saved in response to receiving an instruction that a patent application has been allowed." The Rejection states that this limitation is taught by Simpson at col. 7, lines 14-34 and by MacPhail at col. 1, lines 55-67 and col. 2, lines 1-3.

The referenced portion of Simpson discloses how docketing due dates can be tracked in a spreadsheet. There is no disclosure within that portion of Simpson, or any where else in the reference for that matter, of the claimed workflow rules. Similarly, the referenced portions of MacPhail discloses that document retention and deletion strategies are desirable and that decisions to keep or delete a document may be more complicated than the prior art systems known to the MacPhail inventors allowed for. At best MacPhail suggests that decisions to delete documents may be made based on document types. It does not teach or suggest, or combined with Simpson to teach or suggest that workflow rules may be developed that define types of

documents to be deleted from a database in response to receiving an instruction that a patent application has been allowed. Accordingly, Applicants respectfully assert that a *prima facie* case of obviousness has not been established for claim 17 or claim 18, which depends from claim 17, for at least this additional reason.

D. Claims 19-33:

Claim 19 recites, among other elements, "storing [a] plurality of electronic documents [associated with a patent application] in a computer-readable memory, wherein the plurality of electronic documents includes a first plurality of electronic documents that are desired to be maintained in the computer-readable memory after the allowance and granting of a patent from the patent application and a second plurality of electronic documents that are desired to be deleted after the allowance or granting of a patent from the patent application".

As discussed above with respect to claim 1, none of the cited references taken either separately or combine to teach this aspect of the invention. Accordingly, Applicants respectfully assert that the Examiner has not established a *prima facie* case of obviousness for claim 19 and its dependents. Applicants also note that the Examiner has again not explained the pertinence of the various references applied against the claim. For example, the Examiner seems to argue that the above limitation is met by the combination of in Simpson and MacPhail but in doing so simply states "see [Simpson] 1:22-44; 2:1-55; MacPhail: Abstract, 1:59-67; 2:1-4". Office Action, page 10, line 6. If the Examiner is to maintain this rejection, Applicants request that he explicitly point out what in the Simpson and/or MacPhail references corresponds to the first and second plurality of electronic documents recited in the claim.

In view of the above, Applicants respectfully request withdrawal of the Section 103 rejection of claim 19 and its dependent claims, 20-26.

Applicants further assert that claim 27 and its dependents are allowable over the cited art for at least the same reasons. Accordingly, Applicants respectfully request withdrawal of the Section 103 rejection of claim 27 and its dependent claims, 28-33.

Appl. No. 09/997,269
Amdt. dated June 10, 2004
Reply to Office Action of January 21, 2004

PATENT

New Claims 34-43

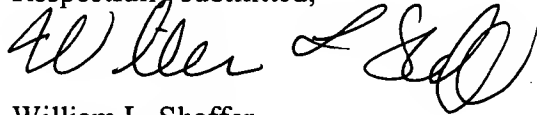
New claims 34-43 have been added to secure an appropriate scope of protection for the present application. It is respectfully asserted that none of the new claims are taught or suggested by the prior art. Examination and allowance of the claims is requested.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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